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Franklin Gray Patents, LLC
Tel: 405-812-5613
Fax: 405-440-2465**DATE:** February 21, 2006**PAGES:** 10 (inclusive)**REPLY BRIEF**

In re the Application of:

Leland James Wiesehuegel)

Serial Number: 09/801,613)

Group: 3625

Docket Number: AUS920010024US1)

Examiner: James H. Zurita

Filed on: 03/08/2001)

For: "Read-only User Access for Web
Based Auction")**Certificate of Transmission under 37 CFR §1.8**

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In the United States Patent and Trademark Office***Identification Page per MPEP 1208 (I) (A)*****RECEIVED
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REPLY BRIEF***Withdrawal of Previous Examiner's Answer***

The first Examiner's Answer, dated June 6, 2005, was withdrawn subsequent to filing of a first Reply Brief by the Appellant. Appellant submitted a revised Appeal Brief responsive to a Notice of Non-Compliant Appeal Brief. The second (present) Examiner's Answer was issued responsive to the second Appeal Brief, withdrawing the previous objections to the first Appeal Brief, but substantially repeating the arguments presented in the first Examiner's Answer with respect to the grounds for Appeal.

The following Appellant's Reply remarks have been exposted from Appellant's first Reply Brief for the consideration of the Board of Patent Appeals

Real Party in Interest per 37 CFR §41.37(c)(1)(i)

The subject patent application is owned by International Business Machines Corporation of Armonk, NY.

Related Appeals and Interferences per 37 CFR §41.37(c)(1)(ii)

This patent application is related to U.S. Patent Application number 09/714,726, docket number AUS9-2000-0736-US, filed on 11/16/2000, which is currently under Appeal and awaiting mailing of the Examiner's Answer to the Appellant's Brief.

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Status of Claims Page per MPEP 1208 (I) (B)***Status of Claims per 37 CFR §41.37(c)(1)(iii)***

On February 23, 2005, appellant appealed from the final rejections of claims 1 - 23. Independent claims 1, 9, 17, drawn towards a method, a computer-readable medium, and a system according to the invention were amended from their original states on May 17, 2004, and again on Sept. 27, 2004, both of which have been entered. Dependent claims 2 - 8, 10 - 16, and 18 - 23 remain in their originally filed states.

Status of Amendments after Final Rejections per 37 CFR §41.37(c)(1)(iv)

No amendments to the claims have been submitted or entered after final rejections.

Summary of the Claimed Subject Matter per 37 CFR §41.37(c)(1)(v)

Please refer to the Appeal Brief filed October 5, 2005, for a Summary of the Claimed Subject Matter.

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Grounds for Rejection Page per MPEP 1208 (I) (C)***Grounds for Rejection For Which Review is Sought per 37 CFR §41.37(c)(1)(vi)***

Claims 1 - 23 were finally rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Published Patent Application 2002/0059131 to Goodwin (hereinafter "Goodwin").

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Arguments Page per MPEP 1208 (I) (D)***Arguments per 37 CFR §41.37(c)(1)(vii)***

Please refer to Appellant's original arguments in the Appeal Brief filed October 5, 2005, which are maintained by Appellant.

Appellant's Reply to Examiner's Answer

"Contract" versus "Acknowledging Specific Conditions". In the Examiner's Answer dated Dec. 19, 2005, it was argued that the phrase in Goodwin's disclosure paragraph [0111] regarding "bidders may be required to sign on and/or acknowledge specific conditions before receiving information" establishes a pre-existing contract between the offeror and the guest.

A key consideration of the Examiner's rationale for the rejections is whether or not this statement by Goodwin reasonably constitutes disclosure of a previously established binding *contract*, compared to our description and claim of an actual "contract", wherein Goodwin does not specifically employ the term "contract", but instead states bidders may be required to "sign on" or "acknowledge specific conditions" before receiving the controlled or restricted information. At question is whether or not Goodwin's "sign on" or "acknowledg[ment] of specific conditions", constitutes a "contract".

Appellant submits that Goodwin's term "sign on" is used in the online computing context, synonymous to "logging on", such as supplying a username and password. Goodwin's disclosure is silent as to any acts of affixing of a signature to a paper or contract, such as "signing on a dotted line" of an agreement or contract.

To hold that Goodwin's August 10, 2001, disclosure implies that a binding contract can be consummated by an online "sign on" process or simple "acknowledgment of specific conditions" is contrary to the legal conditions of online commerce of the time. For example, electronic signatures as binding legal signatures were established on a US national basis by the Electronic Signatures in Global and National Commerce Act (E-SIGN), which went into effect October 1, 2000, prior to Goodwin's disclosure. According to the Federal Trade Commission (source: <http://www.ftc.gov/os/2001/06/esign7.htm>):

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Careful to preserve the underlying consumer protection laws governing consumers' rights to receive certain information in writing, Congress imposed special requirements on businesses that want to use electronic records or signatures in consumer transactions. Section 101(c)(1) of the Act provides that information required by law to be in writing can be made available electronically to a consumer only if he or she affirmatively consents to receive the information electronically, and the business clearly and conspicuously discloses specified information to the consumer before obtaining his or her consent.

Moreover, Section 101(c)(1)(C)(ii) states that a consumer's consent to receive electronic records is valid only if the consumer "consents electronically or confirms his or her consent electronically, in a manner that reasonably demonstrates that the consumer can access information in the electronic form that will be used to provide the information that is the subject of the consent."

Prior to enactment of E-SIGN, most States had various but specific requirements of process, notification, and records retention in order for an online user agreement to be held as a valid, binding contract.

However, the very existence of laws such as E-SIGN and various state laws governing electronic signatures implies that not all electronic agreements are binding contracts, and more specifically, only certain electronic transactions meeting certain criteria result in binding contracts. Therefore, Appellant submits that it has been the presumption under the law that an online agreement is not a contract unless it meets these types of specific conditions.

Goodwin is silent as to such steps or processes to establish a binding contract to meet such "special requirements" such as those set forth in E-SIGN, for example. Goodwin is also silent regarding the pre-existence of a paper contract (e.g. a traditional contract).

In our disclosure, we specifically discussed "Reseller Master Agreements" ("RMA") as being "contracts". RMAs are well known in business, and are traditionally paper. Certainly, the term connotes a binding contract which could be made available in paper form, if not in paper form by default.

Because Goodwin's electronic "sign on" or "acknowledgment of specific conditions" is

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improperly interpreted in view of our disclosure as disclosing such requirements to establish a contract "in a manner which prevents a guest auction participant from modifying the entitlement schema", as we have claimed, Appellant requests reversal of all final rejections of claims 1, 9 and 17, and of claims 2 - 5, 10 - 13, and 22 - 23. Appellant maintains the separate arguments for claims 1, 9 and 17, and for claims 2 - 5, 10 - 13, and 22 - 23, as set forth in the Appeal Brief, thus preserving the separate groups of claims for consideration by the Board.

Further, in Examiner's rationale, Goodwin's terms regarding the requirement that a bidder "register" at a web site, and provide a "profile" upon registration, before the buyer's ability to "conduct transactions" is "activated", does not constitute consummating a "contract", either, for the same reasons as discussed in the foregoing paragraphs. Certainly many web sites require registration and establishment of a user profile, but this does not necessarily imply a binding contract is established, or that a pre-existing contract is required to be in place, as we have claimed.

Summary

For the foregoing reasons, and for the reasons previously discussed in Appellant's Appeal Brief, it is submitted that the rejections of Claims 1 - 23 were erroneous, and allowance of these claims is respectfully requested.

Respectfully,

/ *Robert Frantz* /

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Claims Appendix

per 37 CFR §41.37(c)(1)(viii)

Clean Form of Amended Claims

Please refer to the Appeal Brief filed October 5, 2005, for a copy of the claims in clean form.

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Evidence Appendix

per 37 CFR §41.37(c)(1)(ix)

No evidence has been submitted by applicant or examiner pursuant to 37 CFR §§1.130, 1.131, or 1.132.

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Related Proceedings Appendix

per 37 CFR §41.37(c)(1)(x)

No decisions have been rendered by a court or the Board in the related proceedings as identified under 37 CFR §41.37(c)(1)(ii).